



REMARKS

Claims 50-77 are pending in the application. Claim 35 was objected to for the reasons discussed on page 2 of the Office Action. Claims 22-24, 28, 29 and 32-38 were rejected under 35 U.S.C. § 102(b) as described on page 4 of the Office Action. Claims 19-29, 34-39 and 44-49 were rejected under 35 U.S.C. § 102(b) as described on page 4 of the Office Action. Claims 19-29, 32-39 and 42-49 were rejected under 35 U.S.C. § 102(e) as described on page 5 of the Office Action. Claims 30 and 31 were rejected under 35 U.S.C. § 103 as described on page 6 of the Office Action. Claims 40 and 41 were rejected under 35 U.S.C. § 103 as described on page 7 of the Office Action. Claims 50, 72 and 75 are the only independent claims.

Applicants extend thanks to the Examiner for conducting the Interview on June 4, 2003. During the Interview, Applicants' representative indicated that the Applicants filed a Declaration under 37 C.F.R. § 1.132 on October 2, 2000, in the parent application 08/964,206, to remove the Hatakeyama '952 reference as applicable prior art. Applicants' representative therefore indicated that the remaining outstanding rejections for independent claims include the 35 U.S.C. § 102(b) rejection of claims 22 and 28 under Hatakeyama '511 and the 35 U.S.C. § 102(b) rejection of claims 19, 22, 25 and 28 under Hatakeyama '781.

The Applicants' representative then indicated that Applicants do not concede that the claims, as they then stood, were not patentable over the cited references. Nevertheless, Applicants representative urged that in the interest of expediting prosecution and to place the application in condition for allowance, Applicants were willing to amend the claims to further distinguish over the '781 reference and the '511 reference.

In particular, Applicants representative discussed a plurality of further limitations, each to be added to each independent claim to further distinguish over the applied prior art. The limitations included:

- 1) indicating that the cavities are hexagonal-shaped, honeycomb-shaped or rhombus-shaped for example as illustrated in Figs. 10 and 12;
- 2) a carbon layer on the substrate having micro-protrusions or micro-cavities, for example as illustrated in Fig. 8 and discussed on page 21, lines 3-6;

3) the embodiments of Figs. 4 and 5, for example discussed on page 17, line 13 through page 19, line 18, wherein a magnetic film layer and/or carbon film layer are formed on micro-protrusions or micro-cavities; and

4) the embodiments as illustrated in Fig. 6, and as discussed on page 19, line 19 through page 20, line 12, wherein the slider member and/or magnetic head comprises a ceramic material and/or smooth curved surface.

The Examiner believed the Assignee's assertion that neither of the cited references teaches the subject matter of the above-discussed items 1-4 within the meaning of 35 U.S.C. § 102.

In light of the discussion with the Examiner during the Interview, newly added independent claim 50 requires, *inter alia*, "forming a magnetic film layer and a protective film layer on said micro-protrusions or said micro-cavities."

In light of the discussion with the Examiner during the Interview, newly added independent claim 72 requires, *inter alia*, "depositing a protective film layer on a substrate."

In light of the discussion with the Examiner during the Interview, newly added independent claim 75 requires, *inter alia*, placing said substrate in a process chamber, "wherein said substrate has a smooth curved sliding surface."

It is respectfully submitted that neither Hatakeyama '511 nor Hatakeyama '781, teaches the above-identified limitations.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the foregoing, it is clear that Hatakeyama '511 and Hatakeyama '781 do not anticipate claims 50, 72 and 75.

Furthermore, as claims 51-71, 73-74 and 76-77 are dependent upon claims 50, 72 and 75, respectively, and therefore include all the limitations thereof, it is respectfully submitted that claims 51-71, 73-74 and 76-77 are additionally novel over Hatakeyama '511 and Hatakeyama '781 within the meaning of 35 U.S.C. § 102.

Because neither Hatakeyama '511 nor Hatakeyama '781 teach: forming a magnetic film layer and a protective film layer on micro-protrusions of micro-cavities as required in independent claim

50; depositing a protective film layer on a substrate as required in independent claim 72; or a substrate having a smooth curved sliding surface as required in independent claim 75, it is respectfully submitted that a combination of the teachings of Hatakeyama '511 and Hatakeyama '781 would additionally fail to teach that which is required in independent claims 50, 72 and 75. Accordingly, it is respectfully submitted that claims 50-77 are patentable over a combination of Hatakeyama '511 in view of Hatakeyama '781 within the meaning of 35 U.S.C. § 103.

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

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